

REMARKS

In the Final Office Action, the Examiner took the following actions:

- (1) rejected claim 26 under 35 U.S.C. § 101 as directed to non-statutory subject matter;
- (2) rejected claims 1-26 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 and 6-12 of co-pending U.S. Patent Application No. 10/720,920 (the "920 application");
- (3) rejected claims 1-26 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-37 and 110 of co-pending U.S. Patent Application No. 10/858,973 (the "973 application");
- (4) rejected claims 1-14, 19-21, and 23-26 under 35 U.S.C. § 102(e) as being clearly anticipated by U.S. Patent No. 6,459,913 to Cloutier et al. ("Cloutier"); and
- (5) rejected claim 22 under 35 U.S.C. § 103(a) as being unpatentable over Cloutier in view of U.S. Patent No. 5,661,788 to Chin ("Chin").

By this Amendment, Applicants propose to amend claims 1, 12, 19, and 26.

Support for the amendments can be found in the specification, for example, at page 32, lines 11-19. Claims 15-18 were previously canceled without prejudice or disclaimer.

Claims 1-14 and 19-26 are pending, with claims 1, 12, 19, and 26 being independent.

Based on the foregoing amendments and the following remarks, Applicants respectfully request reconsideration and withdrawal of the rejections of the pending claims.¹

¹ As Applicants' remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicants' silence as to assertions by the Examiner in the Final Office Action or certain requirements that may be applicable to such rejections (e.g., whether a reference constitutes prior art, ability to combine references, assertions as to patentability of dependent claims) is not a concession by Applicants that such assertions are accurate or such requirements have been met, and Applicants reserve the right to analyze and dispute such in the future.

I. The § 101 Rejection of Claim 26

The Examiner rejected independent claim 26 “under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.” Final Office Action at 3. The Examiner asserted that “[s]ince ‘medium’ is not defined in the disclosure, it may encompass a variety of media ranging from a piece of paper to a carrier signal.” Id. Although Applicants disagree with the Examiner’s assertions, in an effort to advance prosecution, Applicants have amended independent claim 26 to recite “computer-readable storage device.” Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 101 rejection of claim 26.

II. The Nonstatutory Obviousness-type Double Patenting Rejections

The Examiner rejected claims 1-26 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 and 6-12 of co-pending ‘920 application, and rejected claims 1-26 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-37 and 110 of co-pending ‘973 application. Id. Applicants respectfully traverse the nonstatutory obviousness-type double patenting rejections of claim 1-21 for the following reasons.

The Examiner alleged that “claim 1 of the pending application [is] the same as claim 1 of the co-pending [‘920] application except receiving a notification at a server.” Final Office Action at 5. This is incorrect. Even assuming the Examiner’s allegation was correct, which Applicants do not concede, the Examiner’s position does not appear to take into account of amendments presented in both this application and the ‘920 application.

Similarly, the Examiner alleged that “claim 1 of the pending application [is] the same as claim 1 of the co-pending [‘973] application except [for the] displaying step.” Final Office Action at 6. Again, this statement is incorrect, and the Examiner does not appear to have taken into account of amendments presented in both this application and the ‘973 application.

M.P.E.P. § 707.07(f) states, “[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant’s argument and answer the substance of it” (emphasis added). However, the Examiner failed to respond to Applicants’ numerous traversals of the double patenting rejections. See Amendment filed September 4, 2008, at 8-9; Amendment filed January 23, 2009 at 8-9; Amendment filed July 6, 2009 at 9-10; Pre-Appeal Brief Request for Review filed December 17, 2009 at 1-3; and Amendment filed September 9, 2010 at 10-12.

Instead, the double patenting rejection remains identical to the double patenting rejection originally asserted on pages 2-3 of the Office Action mailed June 4, 2008. Moreover, Applicants have amended the claims of this application four times, in each case also traversing the double patenting rejection. See Amendments filed September 4, 2008, January 23, 2009, July 6, 2009, September 9, 2010. In each case, the Examiner has maintained the double patenting rejections, stating that “claim 1 of the pending application [is] the same as claim 1 of the co-pending [‘920] application except receiving a notification at a server” and “claim 1 of the pending application [is] the same as claim 1 of the co-pending [‘973] application except displaying step.” See Office Action mailed June 4, 2008 at 2-3; Final Office Action mailed December 22, 2008 at 2-3; Office Action mailed April 15, 2009 at 2-3; Final Office Action mailed November 13,

2009 at 3-4; Office Action mailed June 22, 2010 at 3-4; and Final Office Action mailed November 18, 2010.

Moreover, as Applicants have previously pointed out, any double patenting rejection over the claims of co-pending applications should be a provisional double patenting rejection. See Amendments filed September 4, 2008 at pages 8-9 including footnote 2; Amendment filed January 23, 2009, pages 8-9; Amendment filed July 6, 2009; Pre-Appeal Brief Request for Review filed December 17, 2009; and Amendment filed September 9, 2010 at 10-12.

Applicants respectfully submit that, in light of Applicants' repeated traversals of the double patenting rejections, numerous amendments filed in this application, the '920 application', and the '973 application', and the clear deficiencies of the merits of the double patenting rejections, the Final Office Action does not comply with MPEP § 707.07(f). The Examiner has not "answer[ed] the substance" of Applicants' numerous traversals of the rejections. For at least these reasons, Applicants respectfully request reconsideration and withdrawal of the double patenting rejections.

III. The § 102(e) Rejection of Claims 1-14, 19-21, and 23-26

The Examiner rejected claims 1-14, 19-21, and 23-26 under 35 U.S.C. § 102(e) as being clearly anticipated by Cloutier. Applicants traverse the § 102(b) rejection of claims 1-14, 19-21, and 23-26 because Cloutier does not disclose each and every element recited in claims 1-14, 19-21, and 23-26.

For example, amended independent claim 1 recites, among other things, "determining whether the preferred device is logged on to receive the notification

without transmitting the notification to the preferred device.” Cloutier does not disclose at least this element of amended independent claim 1.

Instead, Cloutier determines whether a subscriber is reachable by attempting to alert the subscriber via the highest priority devices and if unsuccessful, then the next highest priority device(s). Cloutier, col. 8, lines 55-60; FIG. 9, step 1008. “The controller 402 determines that the subscriber is not reachable only when all of the identified device and alert command has been exhausted.” Cloutier, col. 8, lines 61-63. Because Cloutier discloses determining whether a subscriber is reachable by alerting the device, Cloutier does not disclose “determining whether the preferred device is logged on to receive the notification without transmitting the notification to the preferred device,” as recited in amended independent claim 1.

The Examiner asserted that “Cloutier teaches user’s can specify complex conditions that process each alert to determine whether the subscriber should be alerted via one of the available device.” Final Office Action at 2 (citing Cloutier, col. 1, lines 25-67). (Emphasis in original.) The Examiner also asserted that “[t]he subscriber profile specifies possible devices through which the subscriber may be alerted via a schedule corresponding to each of the devices (abstract, col. 1, lines 25-67 wherein profile also includes a priority level corresponding to each of the devices during time periods when multiple devices are available).” Id.

However, a profile including “a priority level corresponding to each of the devices during time periods when multiple devices are available,” does not disclose that all of the multiple devices identified as available are in fact available to receive a notification. On the contrary, Cloutier is very clear that the identified multiple devices may not

actually be available to receive an alert. “The alert command may include multiple devices, each identified with a priority fields. If such is the case, the controller 402 attempts to alert the subscriber via the highest priority devices and, if unsuccessful, then the next highest priority device(s) is used to generate the alert.” Cloutier, col. 8, lines 56-60 (emphasis added.) Further, Cloutier contemplates the possibility where none of the identified multiple devices are actually available to receive an alert. “The controller 402 determines that the subscriber is not reachable only when all of the identified device and alert command has been exhausted. If reachable, the controller goes to step 104; otherwise, the controller goes to step 1018.” Cloutier, col. 8, lines 63-65. Therefore, the profile of Cloutier does not disclose “determining whether the preferred device is logged on to receive the notification without transmitting the notification to the preferred device,” as recited in amended independent claim 1.

For at least these reasons, Cloutier fails to disclose each and every element recited in amended independent claim 1. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 102(e) rejection of independent claim 1 based on Cloutier.

Amended independent claims 12, 19, and 26, although of different scope, recite elements that are similar to those recited in amended independent claim 1. For at least reasons similar to those reasons set forth above with respect to amended independent claim 1, Cloutier fails to disclose each and every element recited in amended independent claims 12, 19, and 26. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 102(e) rejection of claims 12, 19, and 26 based on Cloutier.

Dependent claims 2-11 and 23-25 depend from amended independent claim 1, dependent claims 13 and 14 depend from amended independent claim 12, and dependent claims 20 and 21 depend from amended independent claim 19. Therefore, dependent claims 2-11, 13, 14, 20, 21, and 23-25 incorporate elements that are missing from Cloutier as explained above, and are allowable at least for similar reasons. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 102(e) rejection of claims 2-11, 13, 14, 20, 21, and 23-25 based on Cloutier.

IV. The § 103(a) Rejection of Claim 22 Based on Cloutier and Chin

Claim 22 depends from amended independent claim 1. As explained above with respect to amended independent claim 1, Cloutier fails to disclose at least “determining whether the preferred device is logged on to receive the notification without transmitting the notification to the preferred device,” as recited in amended independent claim 1.

Chin is directed to a “method and telephone system for selectively answering incoming telephone calls by enabling user selection of a receiving mode that designates telephone numbers and an alert mode that designates how the user will be notified of incoming calls from the designated telephone numbers, and then establishing an idle state.” Chin, Abstract. Chin does not teach or suggest “determining whether the preferred device is logged on to receive the notification without transmitting the notification to the preferred device,” as recited in amended independent claim 1, and the Final Office Action does not dispute otherwise as Chin is relied upon only for its alleged teachings of other elements recited in the dependent claim. Final Office Action at 11-12. Therefore, and without conceding any assertions with respect to Chin, Chin fails to cure the deficiencies of Cloutier.

For at least above reasons, the Final Office Action has failed to clearly articulate a reason why claim 22 would have been obvious to one of ordinary skill in the art in view of the prior art. Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 22, and the rejection under 35 U.S.C. § 103(a) should be withdrawn.

V. Conclusion

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-14 and 19-26 in condition for allowance. Applicants submit that the proposed amendments of claims 1, 12, 19, and 26 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicants' invention. It is respectfully submitted that the entering of the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art

references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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